

REMARKS

Claims 1-6 have been amended. Claims 10 and 13 have been withdrawn. Reconsideration is respectfully requested.

Rejections under 35 USC §112

Claims 1-7, 10-11, and 13-14 have been rejected under 35 USC §112 first paragraph, as the specification not being enabling for a compound of formula I, where R1 and Z are claimed as being two vicinal substituents on their respective rings. Applicant has amended the claims to delete the clause. Reconsideration is requested.

Claim 13 has also been rejected under 35 USC §112 first paragraph, as not being enabled by the specification. Claim 13 has been withdrawn. Reconsideration of the application is requested.

Claim 10 has been rejected under 35 USC §112 second paragraph as being indefinite and under 35 USC §101 as improperly claimed subject matter. Claim 10 has been withdrawn, and the rejection is moot.

Rejections under 35 USC §102

Claims 1-7, 10-11, and 14 have been rejected under 35 USC §102(e) as being anticipated by Mueller et al., WO 03/049542 (filing date December 5, 2002). Applicant's priority in the application is to an application filed in the United Kingdom July 8, 2002 (UK application no. 02168442). The Examiner correctly points out that the claims of the present application differ from the UK application. The Examiner incorrectly concludes however, that this prevents applicant from claiming priority of the claimed subject matter to obviate Mueller as a reference under 35 USC §102 (e).

The only subject matter added to the claims of the present application differing from the priority application is

R1 is lower alkyl-sulfonyl, or lower alkyl substituted by a heterocyclyl-NH- or heterocyclyl-O- wherein heterocyclyl is bound to NH or O via a carbon ring atom;

R4 is halogen; and

R3 is hydrogen and R3' is a radical of the formula Ia as defined for R3 if R3 is hydrogen.

The remainder of the claim 1 can be found in the UK priority document, and is therefore entitled to July 8, 2002 priority date. As none of the above variables are disclosed in Mueller, and the rest of the claim predates Mueller's use as a reference under 35 USC §102(e); Mueller does not anticipate the claimed subject matter. Reconsideration is respectfully requested.

Rejections Under 35 USC §103

Claims 1-11 and 13-14 have been rejected under 35 USC §103(a) as being unpatentable over Armistead et al., WO 01/60816. The Examiner has also rejected claims 1-7, 10-11, and 13-14 under 35 USC §103(a) as being unpatentable over Anantanarayan et al., Wo 00/31063. The rejections are respectfully traversed.


In applying the test for obviousness to chemically similar structures, the Court of Appeals Federal Circuit recently laid out a standard in *Takeda Chemical Industries Ltd. v. Alphapharm Pty. Ltd.*, 83 USPQ2d 1169 (Fed. Cir. 2007). The Court stated, "in many cases involving new chemical compounds, it remains necessary to identify some reason that would have led a chemist to modify a known compound in a particular manner to establish a prima facie case of obviousness. ... in order to find a prima facie case of obviousness (for structurally related compounds), a showing that the 'prior art would have suggested making the specific molecular modifications necessary to achieve the claimed invention' was also necessary."

In the present case, the Examiner has shown nothing in the prior art to suggest making the specific molecular modifications, so the references fail in rendering the claimed invention obvious. Withdrawal and reconsideration are respectfully requested.

Should the Examiner have any questions, please contact the undersigned attorney.

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Respectfully submitted,


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